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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,962	12/28/1998	BRIAN CRUICKSHANK	81749-2	5390

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EXAMINER
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SING, SIMON P

ART UNIT	PAPER NUMBER
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2645

16

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/220,962

Applicant(s)

CRUICKSHANK ET AL.

Examiner

Simon Sing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07/21/2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-23,26-28,31-34,36-46,48-54,56,57,60-67,69 and 71-76 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 24, 25, 29, 30, 35, 47, 55, 58, 59, 68, 70 and 77 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1, 2, 5-11, 16, 21-23, 31-34, 36-46, 50, 56, 57, 60-64, 66, 67, 71 and 73 are rejected under 35 U.S.C. 102(e) as being anticipated by Dawson US 6,252,588.

1.1 Regarding claims 1, 34, 56 and 73, Dawson discloses a method and apparatus for providing an audio-visual e-mail system. Dawson teaches

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generating an information signal [sender's thumbnail picture] relating a stored e-mail message to a sender's [source] graphical image [thumbnail picture] and transmitting the information signal to a recipient's computer for indicating receipt of the stored e-mail message (Figure 10; column 9, lines 49-52; column 16, lines 56-67).

1.2 Regarding claims 2, 16, 44, 45 and 57, as discussed above, Dawson teaches including a sender's picture in the information signal.

1.3 Regarding claims 5, 31 and 60, Dawson teaches transmitting the information signal to a recipient's computer by an e-mail server (Figure 10; column 9, lines 49-52; column 16, lines 56-67).

1.4 Regarding claim 6, Dawson teaches sending the client computer a sender's thumbnail picture indicating that the stored e-mail message have been received.

1.5 Regarding claim 7, the information signal [sender's thumbnail picture] is stored in the e-mail server for subsequent retrieval (Figure 10).

1.6 Regarding claim 8, the information signal is generated after a message has been received (Figure 10).

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1.7 Regarding claims 9, 10, 62 and 63, Dawson teaches determining the source of a message [thumbnail picture] (figure 10).

1.8 Regarding claims 11 and 64, it is inherent that the email server determines the e-mail address of the source of the stored message.

1.9 Regarding claims 21, 43 and 66, Dawson teaches transmitting the stored voice message to the addressee upon request (column 16, lines 56-67; column 17, lines 9-16, 55-63).

1.10 Regarding claims 22 and 67, it is inherent that the information signal is transmitted to recipient's computer when the computer logged on to the e-mail server).

1.11 Regarding claim 23, Dawson teaches a sender keeps a database of thumbnail pictures of recipients (column 15, lines 5-15).

1.12 Regarding claims 32 and 71, Dawson teaches that the sender pre-selects the thumbnail picture (column 13, lines 1-6, 13-18).

1.13 Regarding claims 36 and 50, Dawson teaches that sending the information signal [sender's thumbnail picture] by an e-mail server [notification server].

1.14 Regarding claims 37 and 61, it is inherent that the information signal is stored in an e-mail server.

1.15 Regarding claim 38, it is inherent that an e-mail server [computer server] communicates with a network resource [sender's computer].

1.16 Regarding claim 39, it is inherent that a transmitter within the e-mail server [computer server] transmits the information signal to a recipient's computer.

1.17 Regarding claims 40 and 41, it is inherent that an e-mail server has a receiver for receiving a request [recipient logged onto the server] receiving a notification.

1.18 Regarding claim 42, it is inherent that a transmitter within an e-mail server transmits the information signal to a recipient's computer.

1.19 Regarding claim 46, Dawson teaches that an e-mail server retrieves a sender's thumbnail picture from information it received (Figure 10).

1.20 Regarding claims 51-54, Dawson teaches that a recipient's computer [communication device] is programmed to communication with an e-mail server

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[network computer] and to receive and display the sender's thumbnail picture (Figure 10).

2. Claims 73 and 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Picard et al. US 6,233,318.

2.1 Regarding claim 73, Picard discloses a multi-media messaging system in figures 1-6 (column 3, lines 33-62; column 7, lines 13-19). Picard teaches notifying a recipient of a stored message (column 3, lines 50-51), and announcing a sender's name [information signal] to the recipient [transmitting to a communication device associated with the addressee of the stored message] (column 7, lines 20-23, 29-45). Picard further teaches that audio signals can be sent to the recipient in sound waveform (column 18, lines 35-42).

2.2 Regarding claim 75, Picard teaches announcing a sender's name to a message recipient in a sound waveform. It is inherent the name announcement comprising a plurality of sound waveforms since a name normally includes a first name and a last name.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 9-11, 13-15, 26, 28, 34, 48, 49, 56, 62-65, 69, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. US 5,568,540 in view of Dawson US 6,252,588 and further in view of Kimura et al. US 5,778,054.

3.1 Regarding claims 1, 34, 56 and 73, Greco discloses a messaging system in figures 1 and 2. A call processor 38, acting as a server, generates a message list, each entry in the list comprising an information signal associated with the source of a stored message, and transmits said information signal to a client computer 14 [communications device of an addressee] (column 3, lines 63-67) for display as shown in the second and the fifth columns in figure 2 (column 4, lines 45-51 and 57-59). The information signal generated by the Greco reference includes the source's name (if the caller is a registered user), telephone number, date and time, and types of the message such as voice, fax and e-mail.

Greco fails to teach including a graphical image in the information signal.

However, Dawson discloses a method and apparatus for providing an audio visual e-mail system. Dawson teaches selecting a thumbnail picture or a sender (column 20, lines 51-56), embedding the thumbnail picture [graphical image] in the header of an e-mail, and the thumbnail picture is displayed to a



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recipient so that the sender can be identified immediately without opening the e-mail (column 9, lines 49-52; column 20, lines 56-61).

In addition, Kimura discloses a method and apparatus for displaying images corresponding to an electronic address, such as a telephone number or an e-mail address in figure 5. Kimura teaches adding an image from a video information to the directory number so that a person associated with the directory number can be easily identified (column 4, lines 29-49; Figure 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Greco's system with the teachings of Dawson and Kimura so that a thumbnail picture of a sender would have been embedded in a header to identify a sender, and the picture would have been displayed next to an entry in a message list, because such a modification would have enabled a recipient to identify a sender immediately.

3.2 Regarding claims 9-11 and 62-64, the Greco reference, modified by Dawson and Kimura, Greco further teaches determining the source of a message, including a caller's telephone number, name and graphical image [thumbnail picture] (figure 2).

3.3 Regarding claims 12, 13 and 15, as discussed above in claim 1, the Greco reference, modified by Dawson and Kimura, teaches requesting of a sender information [caller ID or e-mail address] from the sender's telephone or computer

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[networked device associated with the source] and receive a sender's information including the thumbnail picture.

3.4 Regarding claim 14, the Greco reference, modified by Dawson and Kimura, teaches storing a message in server 38 and generating an information signal, which also stored in the server 38 as shown in figure 2.

3.5 Regarding claims 17-20, 48 and 65, the Greco reference, modified by Dawson and Kimura, Greco further teaches determining the media type of a message (text for e-mail) and generating a graphical image embedded the information signal (column 2, lines 19-24; figure 2).

3.6 Regarding claims 26, 28, 49 and 69, the Greco reference, modified by Dawson and Kimura, teaches including a graphical image, derived from video information as discussed in claims 1, 34 and 56.

3.7 Regarding claim 74, the Greco reference, modified by Dawson and Kimura, teaches including a graphical image, derived from video information, in the information signal. It is inherent that the modified Greco reference would have been enabled a sender to include more than one graphical images, which would have been embedding the information signal.

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4. Claims 27 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. US 5,568,540 in view of Dawson US 6,252,588 and further in view of Kimura et al. US 5,778,054 and further in view of Picard et al. US 6,233,318.

4.1 Regarding claim 27, the Greco reference, modified by Dawson and Kimura, teaches including a graphical image, derived from video information, associated with the sender of a stored message in the information signal, but fails to specifically teach that the stored message includes a stream of video data, and the graphical image is derived from the stream of video data.

However, Picard discloses a multi-media messaging system configured for voice, fax, e-mail and video messages (column 6, lines 29-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Greco reference, which was modified by Dawson and Kimura, with the teaching of Picard, so that the stored message would have included a stream video data, and the image would have been obtain from the video data, because the Greco's system was a multi-media system which inherently would have included video messaging capability, and selecting an image from which video information would have been a matter of design choice.

4.2 Regarding claim 76, the Greco reference, modified by Dawson and Kimura, teaches including a graphical image, derived from video information,

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associated with the sender of a stored message in the information signal, but fails to specifically teach that the stored message includes a stream of video data, and the graphical image is derived from the stream of video data.

However, Picard discloses a multi-media messaging system configured for voice, fax, e-mail and video messages (column 6, lines 29-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Greco reference, which was modified by Dawson and Kimura, with the teaching of Picard, so that the stored message would have included a stream video data, and more that one image would have been obtain from the video data, because the Greco's system was a multi-media system which inherently would have included video messaging capability, and selecting more than one image from which video information would have been a matter of design choice and within the capability of the modified Greco system.

5. Claims 33 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. US 5,568,540 in view of Dawson US 6,252,588 and further in view of Kimura et al. US 5,778,054 and further in view of Dunn 5,651,054.

The Greco reference, modified by Dawson and Kimura, teaches including a graphical image of the sender of a stored message in the information signal, Greco further teaches that if the client computer is connected to the server 39 via network 30, the information of a voice message from a caller being recorded by

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the server is forwarded to the client computer (column 3, lines 61-67). Greco fails to teach interrupting the storage of the voice message and connecting the caller with a user at the client computer 14.

However, Dunn discloses a method and apparatus for monitoring a message. Dunn teaches that client computer 14 is alerted when an incoming message is being stored (figure 5, reference numeral 161), and a subscriber may click on the TAKE CALL button to interrupt the storage and be connected to the caller (column 6, lines 20-24).

Since the Dunn's system is similar to Greco's, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Greco's reference, which was modified by Dawson with the teaching of Dunn, so that a message status would have been included in the message list and a TAKE CALL function would have been added, because such a modification would have enabled a subscriber to screen an incoming voice message, and to answer the call if he or she so desired.

***Allowable Subject Matter***

6. Claims 3, 4, 24, 25, 29, 30, 35, 47, 55, 58, 59, 68 and 77 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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6.1 Claims 3, 4, 35, 55, 58 and 59 disclose a method for identifying a network location where at least one graphical image associated with the source of a stored message can be accessed by a message recipient, and including the network location in an information signal transmitted to the recipient for indicating the receipt of the stored message. This method is not taught by Dawson, Greco and Kimura, either alone or in combination.

6.2 Claims 24, 25 68 and 77 discloses a method for including a graphical image and a sound waveform associated with the source of a stored message can be accessed by a message recipient. This method is not taught by Dawson, Greco and Kimura, either alone or in combination.

6.3 Claims 29, 30, 47 and 70 discloses a method for adding at least a portion of an information signal [indicating receipt of a stored message] to a web page accessible by an message recipient. This method is not taught by Dawson, Greco and Kimura, either alone or in combination.

### ***Response to Arguments***

7. Applicant's arguments filed on 07/21/2003 have been fully considered but they are not persuasive.

7.1 Claims 1, 34, 56 and 73 over Dawson: The applicants argue that Dawson does not teach not disclose a method for indicating of receipt of a stored

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message. However, Dawson discloses sending a message sender's thumbnail picture to a recipient as shown in Figure 10 to indicate receipt of a stored message [e-mail] waiting for retrieval.

7.2 Claim 73 over Picard: The applicants argue that Picard does not teach the full limitation of claim 73. However, claim 73 states: "... at least one of (limitation) A and (limitation) B". Examiner interprets either A or B alone reads on this claim. Picard teaches announcing a message sender's name to a message recipient, which notifies the recipient that a message has been received and stored.

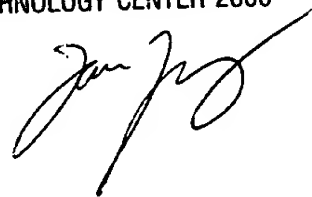
### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

S.S.

10/06/2003

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', written over the printed name and title.